

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MATTEL INCORPORATED

Appeal No. 2003-0162
Reexamination Control No. 90/004,769¹

ON BRIEF

Before STONER, Chief Administrative Patent Judge, NASE and BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 3, 5 to 8 and 62-64, which are all of the claims pending in this application.

We AFFIRM.

¹ This reexamination proceeding was before this panel of the Board of Patent Appeals and Interferences in Appeal No. 1999-2373 (decided October 29, 1999).

BACKGROUND

The appellant's invention relates to a toy vehicle painted with a paint containing thermochromic material which changes color as the temperature of the vehicle varies (specification, p. 1). A clean copy of the claims under appeal is set forth in the opinion section below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kito et al. (Kito)	4,421,560	Dec. 20, 1983
Adachi	JP 50-90795 ²	July 31, 1975

Claims 1 to 3, 5 to 8 and 62-64 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

² In determining the teachings of Adachi, we will rely on the translation already of record in this proceeding.

Claims 1 to 3, 5 to 8 and 62-64 stand rejected under 35 U.S.C. § 112, first paragraph, because the specification while enabling for a cab, does not reasonably provide enablement for a private car, police car or ambulance.

Claims 1 to 3, 5, 7, 8 and 62 to 64 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Adachi.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Adachi in view of Kito.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 29, mailed September 26, 2001) and the answer (Paper No. 46, mailed July 11, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 45, filed May 28, 2002) and reply brief (Paper No. 47, filed September 11, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, to the appellant's evidence of nonobviousness, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Claimed subject matter

The claims on appeal read as follows:

1. A toy vehicle comprising a vehicle body having an initial appearance resulting from at least a portion of said vehicle body being coated with thermochromic paint means having an initial color, said thermochromic paint means for changing said initial appearance by changing said initial color in response to temperature variation of said vehicle body, said thermochromic paint means including thermochromic material capable of changing color due to said temperature variation in order to vary said initial appearance of said vehicle from a private vehicle to at least one of a cab, a police car or an ambulance, or vice versa.
2. The toy vehicle of claim 1 wherein said thermochromic paint means comprises thermochromic paint containing said thermochromic material painted onto said body.
3. The toy vehicle of claim 2 wherein substantially all of said vehicle body is painted with said thermochromic paint.
5. The toy vehicle of claim 2, wherein substantially all of said vehicle body is coated with said thermochromic paint containing said thermochromic material.
6. The toy vehicle of claim 1 wherein said thermochromic material changes color from a colored opaque material resembling a private vehicle to a

transparent material resembling at least one of a cab, a police car or an ambulance, or vice versa.

7. The toy vehicle of claim 1 wherein said vehicle body is made out of metal.

8. The toy vehicle of claim 1 wherein said vehicle body is made out of plastic.

62. A toy vehicle comprising a vehicle body having an initial appearance resulting from at least a portion of said vehicle body being coated with thermochromic paint means forming at least one letter having an initial color, said thermochromic paint means for changing said initial appearance by changing said initial color of said letter in response to temperature variation of said vehicle body, said thermochromic paint means including thermochromic material capable of changing color due to said temperature variation in order to vary said initial appearance of said vehicle from a private vehicle to at least one of a cab, a police car or an ambulance, or vice versa.

63. A toy vehicle comprising a vehicle body having an initial appearance resulting from at least a portion of said vehicle body being coated with thermochromic paint means forming at least one number having an initial color, said thermochromic paint means for changing said initial appearance by changing said initial color of said number in response to temperature variation of said vehicle body, said thermochromic paint means including thermochromic material capable of changing color due to said temperature variation in order to vary said initial appearance of said vehicle from a private vehicle to at least one of a cab, a police car or an ambulance, or vice versa.

64. A toy vehicle comprising a vehicle body having an initial appearance resulting from (a) a first portion of said vehicle body being coated with a first thermochromic paint means for changing said initial appearance in response to temperature variation of said vehicle body, said first thermochromic paint means including a first thermochromic material and (b) a second portion of said vehicle body being coated with a second thermochromic paint means for changing said initial appearance in response to temperature variation of said vehicle body, said second thermochromic paint means including a second thermochromic material, said first and second thermochromic materials capable of changing color due to said temperature variation from a first color at a first temperature to a second color at a second temperature in order to vary said initial appearance of said vehicle body to a substantially different appearance, wherein said first

thermochromic material changes color from a colored opaque material to a transparent material in order to vary said initial appearance of said vehicle body from a private vehicle to at least one of a cab, a police car or an ambulance, or vice versa.

The indefiniteness rejection

We will not sustain the rejection of claims 1 to 3, 5 to 8 and 62-64 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is

not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

Furthermore, the appellant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 213-14, 169 USPQ 226, 228-29 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, we turn to rationale set forth by the examiner (final rejection, pp. 2-3) for the rejection under 35 U.S.C. § 112, second paragraph. The examiner found that all the claims recite a private vehicle, a police car and an ambulance. The examiner stated that such vehicles (i.e., private vehicles, police cars and ambulances) come in many shapes and colors and have great variations. From this, the examiner concluded it was not clear what the metes and bounds of these limitations (i.e., a private vehicle, a police car and an ambulance) were.

The appellant argues (brief, pp. 5-10; reply brief, pp. 1-3) that the claims under appeal are definite as required by the second paragraph of 35 U.S.C. § 112. We agree.

The specification provides (column 3, lines 21-25) that

[d]ramatic results may be obtained by changing the temperature of the body 12 or thermochromic material. For example, as the temperature changes the toy vehicle 10 shown in FIG. 3 changes from a private vehicle to a cab, or vice versa. Numerous other changes are possible such as changing a private vehicle into a police car, ambulance, etc.

The specification also teaches (column 2, lines 9-16) that

Selected portions of the toy vehicle may be painted with the paint containing thermochromic material to provide a variety of patterns, designs, numbers, letters, or other indicia which change color in response to temperature variations. In addition, different portions of the toy vehicle may be painted with different paints containing different colored thermochromic materials.

In our view, the claims do set out and circumscribe a particular area with a reasonable degree of precision and particularity when the language employed in the claims is properly analyzed in light of the application's disclosure as it would be interpreted by one possessing the ordinary level of skill in this art and the teachings of the prior art. In that regard, it is our opinion that one of ordinary skill in the art would understand Figure 3 as depicting a toy vehicle which changes from a private vehicle to a cab, or vice versa, by hiding or displaying the letters CAB. Likewise, it is our belief

that one of ordinary skill in the art would understand the appellant's teaching that numerous other changes are possible such as changing a private vehicle into a police car or ambulance could be accomplished by having a toy vehicle which changes from a private vehicle to a police car or ambulance, or vice versa, by hiding or displaying the letters POLICE or AMBULANCE.

We consider the claims under appeal to be definite, as required by the second paragraph of 35 U.S.C. § 112, since they define the metes and bounds of the claimed invention with a **reasonable** degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). That is, one of ordinary skill in the art from the appellant's specification would understand the claimed language (i.e., "to vary said initial appearance of said vehicle from a private vehicle to at least one of a cab, a police car or an ambulance, or vice versa" to require the toy vehicle to vary its appearance by hiding or displaying the letters CAB, POLICE or AMBULANCE. We note that while claim 62 requires a color changing letter, claim 63 requires a color changing number and claim 64 requires two color changing portions, these limitations would not, by themselves, vary an initial appearance of a toy vehicle from a private vehicle to either a cab, a police car or an ambulance since private vehicles do have letters, numbers and two colors.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 3, 5 to 8 and 62 to 64 under 35 U.S.C. § 112, second paragraph, is reversed.

The enablement rejection

We will not sustain the rejection of claims 1 to 3, 5 to 8 and 62-64 under 35 U.S.C. § 112, first paragraph.

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a nonenablement rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed.

Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court,

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the

disclosure as a guide. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973). In making the determination of enablement, the examiner shall consider the original disclosure and all evidence in the record, weighing evidence that supports enablement³ against evidence that the specification is not enabling.

Thus, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. The threshold step in resolving this issue as set forth supra is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement.

In this rejection, the examiner stated (final rejection, p. 3) that while the specification was enabling for a cab, the specification does not reasonably provide enablement for a private car, police car or ambulance. The examiner then declared that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to replicate the inventions commensurate in scope with the claims under appeal.

³ The appellant may attempt to overcome the examiner's doubt about enablement by pointing to details in the disclosure but may not add new matter. The appellant may also submit factual affidavits under 37 CFR § 1.132 or cite references to show what one skilled in the art would have known at the time of filing the application.

Clearly, the examiner has not met his burden of proof by advancing acceptable reasoning inconsistent with enablement. In applying the above-noted test for enablement, factors which must be considered by the examiner in determining whether a disclosure would require undue experimentation include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) citing Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

Our review of the record reveals that the examiner has not applied the above-noted factors to determine that undue experimentation would be required to practice the invention or provided an explanation that clearly supports such a determination. Since the examiner has not weighed the factors, the examiner's conclusion of nonenablement cannot be sustained. In this case, the examiner has merely stated that the disclosure is inadequate. This is clearly not sufficient to meet the examiner's initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.

Furthermore, we agree with the appellant's view (brief, pp. 11-12; reply brief, pp. 3-7) that the claims under appeal are enabled as required by the first paragraph of 35 U.S.C. § 112. In that regard, one skilled in the art could easily make and use the claimed invention without undue experimentation by providing a toy vehicle with thermochromic paint having the letters CAB, POLICE or AMBULANCE so as to be able to vary its appearance by hiding or displaying the letters CAB, POLICE or AMBULANCE.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 3, 5 to 8 and 62-64 under 35 U.S.C. § 112, first paragraph, is reversed.

The anticipation rejection

We will not sustain the rejection of claims 1 to 3, 5, 7, 8 and 62 to 64 under 35 U.S.C. § 102(b).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Adachi discloses a toy vehicle, for use in a bath, coated with thermochromic paint on portions or the entirety thereof (translation, page 2). As shown in Figures 1 through 3, the thermochromic paint may be applied so as to make marks and designs or patterns appear with an increase in temperature caused by placing the toy vehicle in warm bath water. Adachi's teaching (translation, page 2) that the color change can be used to indicate when the bath water has become less warm or hot makes clear that Adachi contemplates the use of a thermochromic material which is capable of undergoing reversible color change.

The examiner considered (final rejection, p. 4) that the marked toy car of Adachi is a police car and thereby anticipates claims 1 to 3, 5, 7, 8 and 62 to 64. The examiner then stated that the markings "are seen to be letters/numerals in a foreign language or to include such, as appropriate for any such vehicle."

The appellant argues (brief, p. 13; reply brief, pp. 8-9) that Adachi does not disclose a toy vehicle which varies its appearance from a private vehicle to a cab, a police car or an ambulance. We agree. While the toy car of Adachi does vary its appearance by changing from an unmarked toy vehicle to a marked toy vehicle, we see no disclosure in Adachi and the examiner has not cited to any disclosure that Adachi's marked toy vehicle is a police car, cab or ambulance. In that regard, we fail to find any

basis in Adachi for the examiner's statement that the markings in Adachi "are seen to be letters/numerals in a foreign language or to include such, as appropriate for any such vehicle."

Since all the limitations of claims 1 to 3, 5, 7, 8 and 62 to 64 are not disclosed in Adachi for the reasons set forth above, the the decision of the examiner to reject claims 1 to 3, 5, 7, 8 and 62 to 64 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejections

We sustain the rejection of claims 1 to 3, 5 to 8 and 62-64 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the prior decision, this panel of the Board took official notice⁴ that the provision of numbers and letters on toy vehicles to simulate race car numbers or words identifying taxi, police and fire vehicles, for example, was extremely well known at the time of the appellant's invention. Since the appellant has not traversed this taking of official notice (that is, the appellant has not challenged the notion that the provision of numbers and letters on toy vehicles to simulate race car numbers or words identifying taxi, police and fire vehicles, for example, was extremely well known at the time of the appellant's invention), then the matter of which notice was taken is considered admitted prior art. See In re Chevenard, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943). Furthermore, the appellant has stated (brief, pp. 14-15) that (1) toy vehicles have traditionally been painted with numbers and letters to simulate an adult-sized vehicle, such as a race car, and (2) it is known to use markings to simulate taxis, police cars, and fire vehicles.

In applying the above-noted test for obviousness, we conclude that the provision of thermochromic letters such as POLICE or TAXI on the Adachi vehicle to simulate either a police vehicle or a cab would have been prima facie obvious from the combined teachings of Adachi and the admitted prior art for the self-evident advantage thereof (i.e, to vary the appearance of the toy vehicle by hiding or displaying the letters POLICE or TAXI).

⁴ See In re Malcolm, 129 F.2d 529, 533, 54 USPQ 235, 238 (CCPA 1942).

The appellant argues (brief, p. 15) that although it is known to use markings to simulate taxis, police cars, and fire vehicles, and although the types of markings (e.g., words, numbers, etc.) may be obvious, the use of thermochromic markings to transform a toy vehicle from a private vehicle to a readily-recognizable vehicle, such as a cab, police car, and ambulance is not obvious. We do not agree. While the applied prior art does not anticipate the claimed subject matter, one of ordinary skill in the art reading the disclosure of Adachi taken with the admitted prior art would have been motivated to use a thermochromic paint that undergoes a dramatic and noticeable color change in the form of thermochromic letters such as POLICE or TAXI on the Adachi vehicle to simulate either a police vehicle or a cab. It follows then that the teachings of Adachi taken with the admitted prior art would have made it obvious at the time the invention was made to a person of ordinary skill in the art to arrive at the claimed subject matter.

For the foregoing reasons, we are satisfied that Adachi taken with the admitted prior art suggests the subject matter of claim 1 to establish a prima facie case of obviousness. Since claims 2, 3, 5, 7, 8 and 62 to 64 have not been argued separately from claim 1, they therefore stand or fall with claim 1. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).⁵

⁵ Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. 37 CFR § 1.192(c)(7).

As to claim 6, Adachi does not disclose the use of a thermochromic paint which changes from a colored opaque material to a transparent material. Adachi does disclose that children "will enjoy playing with [the toy vehicle] if some marks and designs/patterns appear through adding temperature" (translation, page 2). Thus, Adachi teaches or suggests using a thermochromic paint that is capable of undergoing color change with temperature change to make designs/patterns appear and disappear, but does not disclose use of a thermochromic paint capable of changing between colored opaque and transparent. Kito establishes that thermochromic materials having the capability to reversibly change colors between colored opaque and transparent were within the knowledge of one of ordinary skill in the art at the time of the appellant's invention. Thus, it is our opinion that one of ordinary skill in the art, with the knowledge of the teachings of both Adachi, Kito and the admitted prior art, would have immediately envisaged the use of thermochromic paint which changes reversibly between colored opaque and transparent as a suitable means by which to make the letters such as POLICE or TAXI on the Adachi vehicle appear and disappear.

For the foregoing reasons, we are satisfied that Adachi taken with the admitted prior art and Kito suggests the subject matter of claim 6 to establish a prima facie case of obviousness.

Having concluded, for the reasons discussed above, that the teachings of the applied prior art are sufficient to have suggested the subject matter of the claims under appeal to establish a prima facie case of obviousness, we turn now to the appellant's evidence of nonobviousness, which purports to show commercial success of the claimed invention, in the form of a product line marketed as Hot Wheels Color Racers, and copying by others. This evidence includes the declarations by Matthew C. Bousquette, Keith Hippely, Craig A. Apatov and two declarations by Joseph S. Whitaker referred to on pages 15 and 16 of the brief, and a 1998 Mattel Toys catalog, submitted with Paper No. 10 in this proceeding.

For commercial success of a product embodying a claimed invention to have true relevance to the issue of nonobviousness, that success must be shown to have in some way been due to the nature of the claimed invention, as opposed to other economic and commercial factors unrelated to the technical quality of the claimed subject matter. Cable Elec. Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1027, 226 USPQ 881, 888 (Fed. Cir. 1985). With regard to the Color Racers product line, the Apatov affidavit (page 2) evidences a substantial advertising effort in 1988 (four times the resources directed to 1/64 Scale Basic vehicles, whose dollar sales were slightly higher than those for the Color Racers vehicles in 1988). In view of these statistics, it is not clear that any success of the Color Racers product line in 1988 was due to features

of the claimed invention and not to the extensive advertising of these toy vehicles. Further, the evidence does not establish that the sales of the Color Racers were not merely replacements of sales of the basic Hot Wheels vehicles that would have occurred in the absence of the more extensive advertising of the Color Racers. That Mattel reduced its advertising of Color Racers in 1989, to about half the 1988 level as a percentage of total advertising dollars for Hot Wheels products, is of little moment, absent a showing that continued high sales during the first six months of 1989 were not due to the extensive advertising campaign of 1988. See Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 316, 227 USPQ 766, 770 (Fed. Cir. 1985). The sales estimates for the rest of 1989 (Apatov declaration, page 3) are, of course, merely conjecture and, as such, are entitled to no weight. The appellant has not substantiated this conjecture with actual sales figures for 1989 and has not provided any statistics of sales beyond 1989 to show continued success of the Color Racers.

Moreover, it is well settled that commercial success evidence must be commensurate in scope with the claims to which it pertains. In re Dill, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979) and In re Tiffin, 448 F.2d 791, 792, 171 USPQ 294, 294 (CCPA 1971). See also In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983). With regard to the claims under appeal, the appellant's evidence of commercial success and copying by others falls far short of this requirement.

Specifically, the appellant has not submitted any evidence as to how many of the Color Racers sold comprised thermochromic material capable of changing color due to temperature variation in order to vary the initial appearance of the vehicle from a private vehicle to at least one of a cab, a police car or an ambulance, or vice versa. In addition, it is not apparent to us that any of the samples of the competitors' toy cars necessarily possessed any of these features.

Moreover, evidence of secondary considerations, such as commercial success and copying, are but a part of the "totality of the evidence" that is used to reach the ultimate conclusion of obviousness. See Richardson-Vicks Inc. v. Upjohn Co., 122 F.3d 1476, 1483, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997). When all of the evidence is considered, including the totality of the evidence of nonobviousness, it is our opinion that, on balance, the evidence of nonobviousness fails to outweigh the evidence of obviousness discussed above. See Id.

Therefore, the decision of the examiner to reject claims 1 to 3, 5 to 8 and 62-64 under 35 U.S.C. § 103 is affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3, 5 to 8 and 62 to 64 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 1 to 3, 5 to 8 and 62-64 under 35 U.S.C. § 112, first paragraph, is reversed; the decision of the examiner to reject claims 1 to 3, 5, 7, 8 and 62 to 64 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 1 to 3, 5 to 8 and 62-64 under 35 U.S.C. § 103 is affirmed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED

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